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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/788,541

02/27/2004

Richard J. Melker

MELK-103

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08/11/2006

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EXAMINER

STITZEL, DAVID PAUL

ART UNIT

PAPER NUMBER

1616

DATE MAILED: 08/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/788,541	<b>Applicant(s)</b> MELKER, RICHARD J.	
	<b>Examiner</b> David P. Stitzel, Esq.	<b>Art Unit</b> 1616	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-27 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. ____   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____  | 6) <input type="checkbox"/> Other: ____                                     |

**OFFICIAL ACTION**

***Restriction/Election***

Restriction to one of the following inventions is required under 35 U.S.C. § 121:

- I. Claims 1-15 are drawn to a method for making a customized composition for application to a surface, wherein said method comprises mixing a temporary visual indicator with a material to form said customized composition, as classified in class 106, subclass 14.34.
- II. Claims 16-18 are drawn to a customized composition comprising a temporary visual indicator and a non-paint material, as classified in class 424, subclass 405.
- III. Claims 19-27 are drawn to a kit for making a customized composition, wherein said kit comprises: a first compartment containing a temporary visual indicator; a second compartment containing a modifying substance; and instructions, as classified in class 206, subclasses 223 and 568.

1. Inventions II and I are related as a product and a method of making said product, respectively. The inventions can be shown to be distinct if either or both of the following can be shown that: (1) the method of making the product as claimed can be used to make a materially different product; or (2) the product as claimed can be made by another method that is materially different from the instantly claimed method of making said product. See MPEP § 806.05(f). In the instant case, a customized composition as claimed in Invention II can be made by another method that is materially different from the method claimed in Invention I. For example, as opposed to making a customized composition for subsequent application to a surface, wherein said method comprises mixing a temporary visual indicator with a material to form said customized composition as claimed in Invention I, the customized composition claimed in Invention II may alternatively be made by initially spraying a

temporary visual indicator onto a surface, then subsequently spraying a material onto said surface to form said customized composition directly on said surface, thereby obviating the requirement of a pre-mixing step prior to subsequent application to a surface as claimed in the method of Invention I.

Inventions III and I are related as a kit containing instructions for making a customized composition and a method for making a customized composition, respectively. The inventions can be shown to be distinct if either or both of the following can be shown that: (1) the method of making the product as claimed can be used to make a materially different product; or (2) the product as claimed can be made by another method that is materially different from the instantly claimed method of making said product. See MPEP § 806.05(f). In the instant case, a kit containing instructions for making a customized composition as claimed in Invention III can be made by another method that is materially different from the method claimed in Invention I. For example, as opposed to making a customized composition for subsequent application to a surface, wherein said method comprises mixing a temporary visual indicator with a material to form said customized composition as claimed in Invention I, the kit for making a customized composition claimed in Invention III may alternatively contain instructions for making said customized composition that is materially different from the method for making said customized composition as claimed in Invention I. More specifically, the kit for making a customized composition claimed in Invention III may contain instructions that instruct the initial spraying of a temporary visual indicator onto a surface, then the subsequent spraying of a material onto said surface to form said customized composition directly on said surface, thereby obviating the requirement of a pre-mixing step prior to subsequent application to a surface as claimed in the method of Invention I.

Inventions III and II are related as an apparatus (i.e., a kit containing instructions for making a customized composition) and a product made (i.e., a customized composition), respectively. The

inventions can be shown to be distinct if either or both of the following can be shown that: (1) the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a product that is materially different from the instantly claimed product; or (2) the product as claimed can be made by another apparatus that is materially different from the instantly claimed apparatus. See MPEP § 806.05(g). In the instant case, a customized composition as claimed in Invention II can be made by another apparatus that is materially different from the kit claimed in Invention III. For example, as opposed to making a customized composition according to the instructions contained within the kit claimed in Invention III, the customized composition claimed in Invention II may alternatively be made by mixing a temporary visual indicator with a material to form said customized composition within an industrially sized mixing apparatus located within a manufacturing plant, which is materially different from the instantly claimed kit containing instructions for making said customized composition as claimed in Invention III.

Because these inventions are independent and distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, the prior art search required for each respective invention would be divergent, thereby causing an undue search burden. As a result, restriction for examination purposes as indicated is proper. Applicants are therefore required under 35 U.S.C. § 121 to elect a single invention for prosecution on the merits.

2. Claims 1, 2, 5, 15-17 and 22 are generic to a plurality of disclosed patentably distinct species of material selected from the group consisting of: 1. herbicides; 2. pesticides; 3. fertilizers; 4. protectants; 5. sealants; 6. cleansers; 7. polishes; 8. varnishes and lacquers; and 9. topicals. The disclosed species are patentably distinct, each from the other, because they possess different molecular structures, as

well as different chemical and physical properties. Therefore, restriction for examination purposes as indicated is proper.

Even though this requirement is traversed, Applicants are required under 35 U.S.C. § 121 to elect a single disclosed patentably distinct species of material (i.e., herbicide) for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held allowable. Currently, claims 1, 2, 5, 15-17 and 22 are generic. Applicants should also include a listing of all claims, in addition to any claims subsequently added thereto, which are readable upon the species that is elected consonant with this requirement.

3. Claims 1-4, 6, 9-14, 16 and 18-25 are generic to a plurality of disclosed patentably distinct species of temporary visual indicator selected from the group consisting of: 1. phenolphthalein; 2. bromthymol blue; 3. thymol blue; 4. phenol red; 5. cresol red; 6. m-cresol purple; 7. methyl violet; 8. methyl orange; 9. bromocresol green; 10. methyl red; 11. thymolphthalein; 12. alizarin yellow; 13. 3,3-bis[4-hydroxyphenyl]-1-[3H]-isobenzofuranone; 14. thymolphthalein; 15. basonyl green; 16. basonyl blue; 17. diarylmethane; 18. FD&C #2 indigotene; 19. FD&C #2 lake; 20. triarylmethane (pyram blue); 21. FD&C #1 triphenylmethane; 22. FD&C #1 lake; 23. FD&C #5 yellow; 24. pyrazoine; 25. FD&C #3 green; 26. triphenylmethane; 27. FD&C #3 red; 28. erythrosine powder; and 29. FD&C #5 yellow lake. The disclosed species are patentably distinct, each from the other, because they possess different molecular structures, as well as different chemical and physical properties, as particularly evidenced in claims 4, 9, 11-14, 20 and 24. Therefore, restriction for examination purposes as indicated is proper.

Even though this requirement is traversed, Applicants are required under 35 U.S.C. § 121 to elect a single disclosed patentably distinct species of temporary visual indicator (i.e., phenolphthalein) for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held

allowable. Currently, claims 1-4, 6, 9-14, 16 and 18-25 are generic. In addition to including a listing of all claims, as well as any claims subsequently added thereto, which are readable upon the elected species, Applicants should also include a chemical structure of the elected compound, if a chemical structure of said compound is not already contained within the instant specification.

4. Claims 2, 7, 8, 22, 26 and 27 are generic to a plurality of disclosed patentably distinct species of modifying substance selected from the group consisting of: 1. a monoamine; 2. a diamine; 3. a cyclic amine; 4. hydrochloric acid; 5. thionyl chloride; 6. acetic acid; 7. malic acid; 8. tartaric acid; 9. butyric and isobutyric acid; 10. valeric and isovaleric acid; 11. hexanoic acid; 12. 3-methylvaleric acid; 13. "hetanoic acid;" and 14. nonanoic acid. The disclosed species are patentably distinct, each from the other, because they possess different molecular structures, as well as different chemical and physical properties. Therefore, restriction for examination purposes as indicated is proper.

Even though this requirement is traversed, Applicants are required under 35 U.S.C. § 121 to elect a single disclosed patentably distinct species of modifying substance (i.e., "hetanoic acid") for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held allowable. Currently, claims 2, 7, 8, 22, 26 and 27 are generic. In addition to including a listing of all claims, as well as any claims subsequently added thereto, which are readable upon the elected species, Applicants should also include a chemical structure of the elected compound, if a chemical structure of said compound is not already contained within the instant specification.

#### ***Conclusion to Restriction Requirement***

The Examiner has required restriction between product and methods of making claims. Where Applicant elects claims directed to a product, and the product claim is subsequently found allowable, withdrawn methods of making that depend from or otherwise include all the limitations of the

allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. Methods of making claims that depend from or otherwise include all the limitations of the patentable product claim will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined methods of making claims will be withdrawn, and the rejoined methods of making claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. §§ 101, 102, 103 and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and methods of making claims may be maintained. Withdrawn methods of making claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicants are advised that the methods of making claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. Failure to do so may result in a loss of the right to rejoinder. Further, note that the prohibition against double patenting rejections of 35 U.S.C. § 121 does not apply where the restriction requirement is withdrawn by the Examiner before the patent issues. See MPEP § 804.01.

***Applicants are advised that a fully responsive reply to this requirement must include an explicit identification of a single disclosed patentably distinct species of: 1. material (i.e., herbicide); 2. temporary visual indicator (i.e., phenolphthalein); and 3. modifying substance (i.e., "hetanoic acid"); that is elected consonant with this requirement, and a listing of all claims, including any***



*claims subsequently added thereto, which are readable upon the elected species. An argument that a claim is allowable or that claims are not generic is considered nonresponsive unless accompanied by an explicit election of a specific species and subspecies. See 37 C.F.R. § 1.143.*

Should Applicants traverse on the ground that the species are not patentably distinct, Applicants should submit evidence or identify such evidence now of record showing the species and subspecies to be obvious variants over one another or clearly admit on the record that this is the case. In either instance, if the Examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103(a) of the other inventions.

If claims are added after the election, Applicants must explicitly indicate which claims are readable upon the elected species. See MPEP § 809.02(a). Amendments submitted after final rejection are governed by 37 CFR 1.116, whereas amendments submitted after allowance are governed by 37 CFR 1.312.

Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR § 1.48(b) if one or more of the currently named Inventors is no longer an actual Inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR § 1.48(b) and by the fee required under 37 CFR § 1.17(i).

Due to the complex nature of the instant restriction requirement, a written restriction requirement was necessitated. See MPEP § 812.01.

#### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to David P. Stitzel, M.S., Esq., whose telephone number is 571-272-8508. The Examiner can normally be reached on Monday-Friday, from 7:30AM-6:00PM.

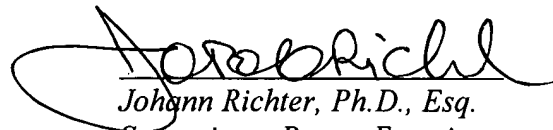
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Examiner: David P. Stitzel, Esq.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Johann Richter, Ph.D., Esq., can be reached at 571-272-0646. The central fax number for the USPTO is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published patent applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished patent applications is only available through Private PAIR. For more information about the PAIR system, please see <http://pair-direct.uspto.gov>. Should you have questions about acquiring access to the Private PAIR system, please contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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